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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#9/Election
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AUG 13 2002

TECHNOLOGY CENTER 2800

IN RE APPLICATION OF:

:

Toshiya IMAI, et al.

: EXAMINER: EASTHOM, K

SERIAL NO: 09/677,886

:

FILED: OCTOBER 3, 2000

: GROUP: 2832

FOR: NONLINEAR RESISTOR AND METHOD
OF MANUFACTURING THE SAME

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER OF PATENTS
WASHINGTON, DC 20231

SIR:

In response to the Election of Species Requirement stated in the Official Action dated July 11, 2002, Applicants provisionally elect Species 17, as shown in Sample 17 in Table 1, and identify Claims 3-8 and 11 as readable on the elected species.

Applicants respectfully traverse the outstanding election requirement for several reasons.

First, the outstanding Office Action asserts that "[t]his application contains claims directed to the ... patentably distinct species of the claimed invention...." However, MPEP §816 states the following:

If the particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given....

The outstanding Election Requirement merely provides the aforementioned conclusory statement and does not present particular reasons for such a holding. Hence, Applicants respectfully submit that in the absence of any annunciated basis, the PTO has not carried its burden of proof stated in MPEP §816.

Further, MPEP §806.04(f) states:

Claims to be restricted to different species must be mutually exclusive.

The outstanding Election Requirement omits any statement or basis for finding the Claims “mutually exclusive.” Therefore, the PTO has not carried the burden implied by MPEP §806.04(f), and on that basis, Applicants further traverse the Election Requirement.

Furthermore, MPEP §803 states the following:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Claims 8 and 14 of the present application are directed to a non-linear resistor. Thus, it appears that all claims in the present application are part of an overlapping search area and that a search for Claims 3-8 and 11 would necessarily include a search directed to the claims readable on the non-elected species as well. Applicants therefore respectfully submit that there is no undue burden on the Examiner to search all the claims under MPEP §803, and traverses the Election of Species Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single disclosed species be withdrawn, and that a full examination on the merits of each of Claims 3-20 be conducted.

Respectfully submitted,

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RE: Application Serial No.: 09/677,886
Applicants: Toshiya IMAI, et al.
Filing Date: October 3, 2000
For: NONLINEAR RESISTOR AND METHOD OF
MANUFACTURING THE SAME
Group Art Unit: 2832
Examiner: EASTHOM, K

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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